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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,647	12/05/2003	Jerry Brower	2295-003	8426
20575	7590	02/21/2006	EXAMINER	
MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204				ZIRKER, DANIEL R
ART UNIT		PAPER NUMBER		
		1771		

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/728,647	BROWER, JERRY
	Examiner Daniel Zirker	Art Unit 1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 12-17 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 December 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

<ol style="list-style-type: none"> <li>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/7/04</u>.</li> </ol>	<ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol>
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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to a wall patch, classified in class 428, subclass 63.
  - II. Claims 12-17, drawn to a method of repairing a wall hole, classified in class 156, subclass 98.
2. The inventions are independent or distinct, each from the other because:
3. Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process such as in adhesive bonding processes including attachment of the patch as a label to a substrate which does not have any holes therein.
4. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with James Hilsenteger and Examiner John Goff on December 5, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. The Examiner notes for the record that the application as filed did not contain a claim 9, so pursuant to Rule 126 claims 10-18 have been renumbered as claims 9-17. Accordingly, claims 1-11 are now being examined.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in claim 1 and elsewhere "body" is considered to be vague and indefinite and it is suggested to use –sheet— or similar language, applicant taking care to point out where proper support exists. In claim 1 it appears proper to use "having an upper and an opposing lower surface" to describe the surfaces of the "body". Additionally, it would appear desirable if the "aperture" were described more specifically than as just being "in the body". In claim 3, "comprises a texture" is vague and indefinite.

9. The Examiner further notes for the record that although applicant alleges that this case is a CIP of pending SN 10/618,166, which is itself a divisional of SN 09/595,635, now patent 6,607,621, such is not deemed to be the case. More particularly, each of the two parent applications had listed as their sole inventor Randall Eric Swanson, while the present application has listed only a sole inventor, Jerry Brower. Accordingly, the present application cannot be considered to be a CIP of the '166 application and also is believed to have both a defective oath and also a defective first paragraph.

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson, US 6,607,621 taken either individually, or in view of either Owens et al or Hoffman, Sr '949, and for claims 6-8 in further view of Parker '222, the latter reference being taken as evidence of the state of the art. Swanson, as noted above is not the grandfather application in applicant's alleged copendency chain, but rather is prior art to the applicant. The reference discloses a clear anticipation of applicant's most preferred embodiments for claims 1-5 except for the absence of a teaching of the presence of an aperture in the "body", which the Examiner believes is a teaching well within the ordinary skill of the art. Alternatively, each of the secondary references teaches closely related patch structures that are coated on one outer surface with a suitable adhesive and are ready to either paint (Owens et al) or be coated with a suitable repair compound such as paint (Hoffman, Sr) on their opposing opposite surface, each also teaching structures which may contain suitable aperture(s). Note particularly Owens et al, e.g at Col 3, lines 14-15 and Hoffman,Sr , e.g. the Figures. Additionally, as regards the limitations in dependent claims 6-8 regarding apertures which are sized to "surround a wall-mounted element" (claim 6) note Parker, particularly in Figures 4 and 5 and the corresponding disclosure at Col 4, line 42- Col 5, line 16 for an express teaching that one of ordinary skill would have no difficulty in designing hole patches which contained

apertures suitable for "surrounding a wall-mounted element" such as a wall socket or the like. As to the "aperture reinforcement" structures in claims 9-11 these are also believed to be taught beginning at Col 5, line 60 of Swanson. Other parameters that are not expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday- Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker  
Primary Examiner  
Art Unit 1771

